

## REMARKS

This paper is in response to the non-final official action dated December 22, 2005, wherein: (a) claims 1-8 are pending, and (b) claims 1-8 were rejected under 35 USC § 103(a) as being obvious over Kvilstaug U.S. Patent No. 3,916,482 ("Kvilstaug") patent in view of German Publication No. DE 19824966 (the "966 publication"). Reconsideration and withdrawal of the rejections are respectfully requested in view of the following remarks.

### I. The 35 USC § 103(a) Rejection Is Traversed

Claims 1-8 were rejected under 35 USC § 103(a) as being obvious over Kvilstaug in view of the '966 publication. See pp. 2-5 of the action.

#### A. Proper Basis for a § 103(a) Rejection

Three criteria are required to establish a *prima facie* case of obviousness. First, the combined disclosure of the prior art references must teach or suggest all of the claim limitations. Second, there must be some suggestion or motivation to modify or combine the teachings in the art to make the precise combination recited in the claims. Finally, a person having ordinary skill in the art must have a reasonable expectation of success when combining or modifying the disclosures of the references. The suggestion or motivation to make the claimed invention and the reasonable expectation of success must both be derived from the prior art, and not from the application's disclosure. See MPEP §§ 2142-43 (8th ed., October 2005).

A proposed modification to a reference is impermissible if it would render the reference unsatisfactory for its intended purpose. See MPEP § 2143.01(V).

#### B. The Combination of Kvilstaug and the '966 Publication Do Not Teach or Suggest All Features Recited in Claims 1 – 8

The Kvilstaug patent and the '966 publication do not teach or suggest the combination of features recited in claims 1-8. Thus, no *prima facie* case of obviousness has been made in the instant action. Accordingly, reconsideration and withdrawal of the § 103(a) rejection are respectfully requested.

Kvilstaug is directed to a device for cleaving the carcasses of slaughtered animals. It discloses a stand that keeps the carcass in a vertical position during the cleaving operation. See Kvilstaug, col. 1, lines 14-16. Specifically, two vertical posts 2 and a cradle 3 form a stand for a carcass 13. See Kvilstaug, col. 1, lines 43-44 and Fig. 1. The carcass stand may only be moved by *pivoting about its base*, such that *an upper end of the carcass stand is lowered*:

In FIG. 1, an hydraulic or pneumatic means is designated by 4 and having transmission links which are used to swing the posts 2 with the cradle 3 to a left position, as indicated in FIG. 1 by dotted lines. . . .

Kvilhaug, col. 1, lines 47-52 (emphasis added). The distinction between "upper," "lower," "raised," "lowered," etc. is relevant in both the claimed invention and the disclosure of Kvilhaug because of the role of directional gravitational forces in the operation of both processes.

The '966 publication is generally directed to a process and device for the detachment and extraction of fill material from an open channel, and is more specifically directed to a device for the removal of the spinal medulla from a slaughtered animal. See the '966 publication at p. 2 (English translation). The '966 publication does not describe any structure of a broader slaughtering system, stating only that "the forward/backward movement of the connecting unit and of the active device is carried out from the outside via means that are generally familiar in the art." See the '966 publication at p. 5 (English translation). The only described alternative embodiments include the removal of the medulla from bones other than the spine (e.g., the skull). See the '966 publication at p. 9 (English translation).

Taken together, the combination of the Kvilhaug patent and the '966 publication fail to disclose all of the features recited in the claims. Specifically, Kvilhaug discloses only the pivoting of a carcass stand around its lower end, such that the upper end of the carcass stand is lowered, and the '966 publication does not disclose structure beyond the spinal cord removal apparatus. Therefore, the combination fails to disclose (1) the pivoting of a tilting member "such that a lower end of the tilting member is raised" (claims 1 and 8); (2) a tilting member that is "pivotable around an upper end thereof" (claim 2); and, (3) a tilting member that is "pivotable around an intermediate point between the upper end and a lower end thereof" (claim 3).

The action asserts that the piston/cylinder arrangement shown in Fig. 1 of Kvilhaug is analogous to the "plurality of tilting elements which are displaceable relative to each other in a longitudinal direction of the elements" recited in claim 4. See p. 3 of the action. However, interpreting the piston/cylinder arrangement of the hydraulic/pneumatic means 4 (see Kvilhaug, Fig. 1) as part of the tilting member results in the Kvilhaug disclosure having no structure analogous to the recited "drive unit configured to cause the tilting member to pivot" (claim 1). On the other hand, if the piston/cylinder arrangement is interpreted as part of the "drive unit," then the remaining structural elements analogous to a tilting member (i.e., the two vertical posts 2 and a cradle 3) are neither displacable relative to each other nor able to cause a longitudinal extension of the tilting member (claim 4).

Thus, the cited publications fail to teach or suggest all recited claim features.

**C. There is No Motivation to Modify the Combination of Kvilstad and the '966 Publication to Arrive at the Claimed Device**

There is no motivation to modify the cited publications in a way to yield the claimed invention. Kvilstad discloses no structure that would even permit such a modification because it has no means to support the carcass stand that would allow it pivot, thereby raising its lower end. Similarly, the '966 publication discloses no structure beyond its spinal cord removal device.

Further, even if such a modification were made to the device Kvilstad by adding structure necessary to raise the lower end of the carcass stand, it would render the device unsatisfactory for its intended purpose. Specifically, Kvilstad indicates that:

[The upper end of the carcass stand is lowered] in order to allow the carcass 13 to be brought in position when same arrives suspended on hooks which are moved along a conveyor. . . . Said conveyor moves the carcass in the direction perpendicularly to the plane of the drawing.

Kvilstad, col. 1, lines 47-58. Thus, lowering the upper end of the carcass stand in between cleaving operations is required to provide enough clearance for the conveyor 12 to bring the carcass 13 into place. If the lower end of the carcass stand were raised in between cleaving operations, the carcass stand would obstruct the horizontal motion of the carcass 13. See Kvilstad, Fig. 1.

**CONCLUSION**

In view of the foregoing, reconsideration and withdrawal of the rejections, and allowance of all pending claims 1-8 are respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the examiner is urged to contact the undersigned attorney.

Respectfully submitted,

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